REMARKS

Claims 23-41, 43-46, 48-55, and 57-58 remain in the application including independent claims 23, 41, and 48. Claims 42, 47, and 56 have been cancelled. Claims 41 and 43-46 have been allowed. Claims 29-31, 33-35, 49-55, and 57-58 are indicated as allowable if rewritten in independent form.

Claims 23-28, 38 and 39 stand rejected under 35 U.S.C. 102(b) as being anticipated by Van Dest et al. (FR 2507550).

The Van Dest reference is directed toward a drive turret for a lift truck. Lift trucks include forks (or platforms) that are mounted on a turret that is carried up and down a vertical mast. Loads, such as boxes, crates, etc., are picked up by the forks, which are then driven up the mast via the drive turret to place the load on a shelf or rack. Thus, Van Dest is not directed toward an automotive vehicle drive unit assembly for driving vehicle wheel hubs as claimed by Applicant.

Instead of providing a driving force to move a vehicle, the Van Dest drive turret drives a platform up and down a vertical mast and pivots the platform about a vertical axis for material handling purposes. The Van Dest drive turret is described as including a pair of coaxial wheels, each provided with a reducing gear with planetary gear train, a central housing situated between the two wheels and mounted so as to pivot on the vehicle about a vertical axis passing through the middle of the axis of the two wheels, and two electric motors mounted on the housing that are coupled for driving the reducing gear and planetary gear train.

The examiner argues that Van Dest teaches "first and second wheel hubs (3, between tires 1 and gear sets 5)." Applicant traverses this characterization of Van Dest. As discussed above, Van Dest is directed to a drive turret for a lift truck. Thus, none of the components shown in any of the

figures in Van Dest is a tire. Further, there are no wheel hubs in Van Dest that correspond to Applicant's claimed wheel hubs. While it is well settled that terms in a claim are to be given their broadest reasonable interpretation, this interpretation must be consistent with the specification, with claim language being read in light of the specification as it would be interpreted by one of ordinary skill in the art. One of ordinary skill in the art would simply not consider wheel hub 3 of Van Dest as corresponding to Applicant's claimed *rotating* wheel hub, as argued by Examiner. This is especially true as "wheel hub 3" in Van Dest cannot rotate because it is bolted to the central housing 10. Further, one of ordinary skill in the art would not consider rotating element 2 in Van Dest as corresponding to the claimed wheel hub.

Van Dest also clearly does not disclose, suggest, or teach a drive unit as set forth in claims 24-28, 38 or 30. For example, as Van Dest does not teach wheel hubs as claimed by Applicant, Van Dest certainly does not teach incorporation of planetary gear sets into wheel hubs as set forth in claim 24. Further, as hub 3 does not rotate, ring gear 18, 19 cannot be mounted for rotation with the wheel hub as argued by examiner with regard to claim 26.

Claims 23, 26, 32, 36, 37, and 40 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Roe (US 3161083). Claim 23 includes the combination of an electric motor that drives a first gear set, which in turn drives a planetary gear set. Roe teaches a different configuration where a pair of motors drives a planetary gear set, which in turn drives a ring and pinion gear set. The examiner argues that the ring and pinion gear in Roe is capable of driving the planetary gear set when the vehicle is coasting. Claim 23 requires the combination that the electric motor drives a first gear set, which drives a planetary gear set. If the ring and pinion gear of Roe is driving the planetary gear set, then the motor is not driving the first gear set.

Claim 26 includes the feature of the first gear set including a first ring and pinion. As described above, the "first gear set" in Roe is the planetary gear set, not the ring and pinion gear set.

Claim 37 includes the feature of one motor extending out forwardly from the lateral axis of rotation and the other motor extending out rearwardly from the lateral axis of rotation. As shown in Figure 3 of Roe, all motors are positioned on the same side of the lateral axis of rotation. The examiner argues that the features of claim 37 are shown in Figure 1, however, it is clear that Figure 1 is purely schematic and does not show the actual position of the motors (see dashed line connecting planetary 30L to wheel input in Figure 1). The actual position of the motors is clearly defined in Figure 3, which does not teach the features of claim 37.

Claim 24 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Roe in view of Van Dest. As discussed above, neither Roe nor Van Dest disclose, suggest, or teach Applicant's invention as set forth in the claims. Further, Van Dest is not analogous art. "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." In re Oetiker, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). The Van Dest reference is not analogous art to Roe or to Applicant's invention.

The Van Dest reference is not in Applicant's field and is not reasonably pertinent to the particular problem that the Applicant has solved. Drive turret technology for raising lift truck platforms does not include any pertinent information that would help applicant solve problems relating to electrically powering a vehicle to drive down the road.

Also, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. In re Fine, 837 F.2d 1071, 5 USPA2d 1596 (Fed. Cir. 1988). Even if Van Dest is considered analogous art, there is absolutely no teaching, suggestion, or motivation to modify Roe with Van Dest.

The examiner argues that Roe fails to teach planetary gear hubs being incorporated into wheel hubs and relies on Van Dest to teach this feature. The examiner further argues that "it would have been obvious to one of ordinary skill in the art at the time of the invention to provide a planetary gear set, as taught by Van Dest et al., driven by the gear set of Austin as modified by Quartullo, for the purpose of reducing the wheel axle running speed directly at the wheel." Applicant requests further clarification on examiner's motivation to modify Roe with Van Dest as it appears that the motivation set forth by examiner applies to another claim rejection and not that of claim 24. Applicant asserts that there is no motivation to modify the vehicle drive axle of Roe with features from a lift truck drive turret as the respective mechanisms have different operational goals are directed to very different types of technology.

Claim 25 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Roe in view of previously cited Kawamoto. For the reasons, discussed above with regard to claim 23, Roe does not disclose, suggest, or teach the claimed invention.

Claim 48 stands rejected as being unpatentable over Austin in view of Quartullo and further in view of Van Dest. As discussed above, Van Dest is non-analogous art, and is not directed to driving a vehicle wheel as argued by examiner. Also, there is no motivation or suggestion to

modify Austin and Quartullo with the teachings of Van Dest as the teachings of Van Dest are directed toward solving problems very different than those solved by Austin and Quartullo. Finally, for the reasons discussed above, Van Dest does not teach the use of a planetary gear set as claimed by Applicant.

Further, in response to examiner's arguments with regard to providing translations, Applicant makes the following remarks. The Van Dest reference was asserted against Applicant's claims in the previous official action, and because the reference did not have a corresponding English language equivalent, Applicant requested that the examiner obtain a translation of the reference so that Applicant and examiner could more fully under stand the teachings of the reference, especially in light of the examiner's 35 U.S.C. 103(a) rejections.

The examiner argued that, "had the examiner been responsible for the original citation of the reference, it may be appropriate for the examiner to provide a translation." The examiner also argued that because Applicant was responsible for the original citation of the Van Dest reference, it was not appropriate for the examiner to obtain a translation.

First, Applicant does not have a duty to provide the examiner with translations of non-English language references that are cited against Applicant's claims by the examiner. Second, there is nothing in Ex parte Gavin, that places a duty of providing a translation based on who first submitted the reference for consideration. Ex parte Gavin states that in the Board's view, "obtaining translations is the responsibility of the examiner." Ex parte Gavin, 62 USPQ2d 1680, 1684 (U.S. Patent and Trademark Office Board of Patent Appeals and Interferences, 2001). There is no discussion in Ex Parte Gavin that states Applicant must provide a translation of a reference if Applicant submits the reference.

Applicant's representative reviewed the corresponding English abstract for the Van Dest reference and found no particular relevance as Van Dest was directed to a movable platform for a load handling vehicle. Applicant submitted the reference because it was cited in a corresponding foreign search report. The foreign search report indicated that the reference was only relevant as background information. Thus, while Applicant did submit the foreign reference in an information disclosure statement, it was the examiner who *rejected* the claims based on this non-English language reference, relying solely on the drawings. Applicant requested that the examiner obtain a translation such that the rejections under 35 U.S.C. 102 and 35 U.S.C. 103 could be more fully explained. The examiner has access to translation services provided by the United States Patent and Trademark Office, which are funded, at least in part, by Applicant's filing fees. However, as examiner has refused to obtain a translation, and as Applicant did not want to further draw out the prosecution of the application, Applicant obtained a translation of the Van Dest reference. The translation is being submitted in an information disclosure statement filed along with Applicant's response.

For the reasons set forth above, all claims should be allowed. An indication of such is requested. Applicant believes that no additional claim fees are due, however, if additional fees are required the Commissioner is authorized to charge Deposit Account No. 50-1482 in the name of Carlson, Gaskey & Olds.

Respectfully submitted,

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Dated: May 2, 2003

CERTIFICATE OF MAIL

I hereby certify that the enclosed Response is being deposited with the United States Postal Service as First Class Mail, postage prepaid, in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 2 day of May, 2003.

Laura Combs

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